

Appl. No. 09/745,702
Atty. Docket No. 8384
Amdt. dated February 1, 2005
Reply to Office Action of Nov. 1, 2004
Customer No. 27732

REMARKS

Claim Status

Claims 1, 6-10 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC 103(a) Over Richards et al. in view of Hamilton et al. and W.E. Meissner

Claims 1 and 6-10 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et al., hereafter "Richards", in view of U.S. Patent No. 5,662,758 issued to Hamilton et al., hereafter "Hamilton", and U.S. Patent No. 3,111,796 issued to W.E. Meissner, hereafter "Meissner".

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants respectfully traverse the rejection by the Office Action because there is no motivation to make the suggested combination of references.

In support of its rejection the Office Action states:

Richards discloses the claimed invention, but does not expressly disclose that the tubular sheet comprises the adhesive material.

W. E. Meissner discloses, in an invention for closing and sealing a container, that: "for closing and sealing a collapsible container by rupturing a bubble of tacky film-forming material at least within the opening end of the container as that portion of the container is urged into collapsed position" (column 1, lines 31-35). Figure 5 further depicting the closing and sealing of a flexible bag by twisting the bag at the area 53. During this twisting operation, the bubble ruptured and coated the inner wall of the bag with adhesive (column 5, lines 48-55).

Hamilton discloses a flexible film having pressure sensitive adhesive protected from inadvertent adherence

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(abstract); the flexible film having a recessed pressure sensitive adhesive and collapsible protrusions (three-dim' film) which serve as stand-off to prevent premature sticking to wide variety of rigid and resilient target surfaces, wherein the collapsible protrusions are small and closely spaced for releasable sealing of the composite material to such surfaces or even to itself (column 3, lines 20-26)....

W. E. Meissner's teaching provides a motivation for the practitioner in the art to find a flexible material to use as a bag in which the inner surface is coated with adhesive, and when pressure is applied such as twisting, the adhesive material ensures the sealing of the closure of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Richards' tubular sheet by applying the flexible film with adhesive as taught by Hamilton providing an effective closing and sealing of the waste-filled article in which the flexible material having pressure sensitive adhesive that is protected from inadvertent adherence to other surfaces.

(Office Action pages 3-4).

First, the Office Action asserts that Meissner provides a motivation to add an adhesive to a flexible material or container to insure the sealing and the closure of a bag while Richards teaches away from the addition of adhesive to the sealing of its pleated tubing. Caselaw provides that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

Richards teaches that a top of a pleated tubing is pulled upward and tied into a knot thereby forming a bottom of a package. (col. 3, lines 11-14). Richards further teaches that after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Richards also teaches the use of high density

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polyethylene in order to tightly maintain knots that are created. (col. 3, lines 55-60). Moreover, Richards teaches that "[e]ven if the twisted seals between the packages become loosened, the lid and the newly formed topmost twisted seal will prevent the escape of odours, vapours, and gases to the ambient atmosphere." (col. 3, lines 54-57).

Thus, Richards teaches methods and material which insure the sealing and the closing of the pleated tubing without the use of adhesives. Consequently, one skilled in the art, after reading Richards, would be discouraged from utilizing adhesive in sealing or closing the pleated tubing of Richards.

Second, caselaw provides that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. MPEP § 2142 (citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). As mentioned previously, the Office Action asserts that Meissner provides motivation for a practitioner in the art to utilize a bag having an inner surface coated with adhesive such that "when pressure is applied such as twisting, the adhesive material ensures the sealing of the closure of the bag." (Office Action page 3). However, as discussed above, there is no motivation to combine the suggested references. Thus, the Office Action has failed to provide an explanation of why the combination of teachings is proper.

Third, the proposed modification of Meissner and Richards would render Richards unsatisfactory for its intended purpose. While the Office Action states that Meissner provides the motivation to add adhesive to the pleated tubing of Richards, the MPEP § 2141.02 provides that "[a] prior art reference must be considered in its entirety... including portions that would lead away from the claimed invention." § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Furthermore, it is well established that, "[i]f the proposed prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

An objective of Richards is to avoid complicated mechanical devices. (col. 1, lines 47-49). In contrast, however, Meissner teaches the addition of adhesive to insure the sealing and closure of a container via complex machines and processes. Meissner

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teaches that in order to insure sealing and closure of a container, an adhesive "is suspended within the open end of a container, expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed." (col. 2, lines 3-6). Meissner further teaches that "[c]ontrol over the areas of the container walls coated with the adhesive film-forming material may be achieved by selectively positioning the expanded bubble or bubbles of film-forming material relative to the open end of the container." (col. 2, lines 30-34). A mechanical device is required to suspend the adhesive within the open end of the container, and another mechanical device is possibly necessary to expand the adhesive into the form of a bubble. Therefore, the addition of adhesive to insure the sealing and the closure of the pleated tubing of Richards via the process disclosed in Meissner would greatly complicate the sealing and closure of the pleated tubing as disclosed in Richards. Thus, the addition of adhesive to seal or close the pleated tubing of Richards would contravene the intended purpose of Richards, and therefore, there is no motivation to combine Meissner with Richards.

Conclusion

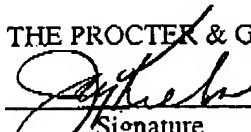
In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of Claims 1 and 6-10 is respectfully requested.

Respectfully submitted,

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